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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,929	06/26/2001	Andreas Herpens	Beiersdorf 722-KGB	3738
27384	7590	10/03/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022			LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,929

Applicant(s)

HERPENS ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 8/1/05 has been entered.

2. Claims pending are 18-49. Claims 48 and 49 are new.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New Claims 48 and 49 introduce new matter as they use the phrase "distarch phosphate **and**/or cyclodextrin". There is no support in the specification for the employment of the claimed combination of the agents. The

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combination of distarch phosphate **and** cyclodextrin was not described in the application as filed, and persons skilled in the art would not recognize in the applicant's disclosure a description of the invention as presently claimed. While describing the compositions containing **either one** of these agents, the specification does not describe or exemplify the **claimed combination**.

Therefore, it is the examiner's position that the disclosure does not reasonably convey that the inventor has possession of the subject matter of the amendment at the time of filing of the instant application.

Claim Objections

5. Claims 19 and 21 are objected to because of the following informalities: they recite the limitation "distarch phosphate **and or** cyclodextrin". The amendment after Final Rejection filed 10/15/04 (entered) deleted the word "and" and thus overcame the 35 U.S.C. 112, first paragraph, rejection of claims 19 and 21-26. See Advisory Action dated 11/8/04. However, the word "and" reappeared in the instant copy of the claims. The Appropriate correction is required, otherwise the rejection of claims 19 and 21-26 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, will be reinstated.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. The rejection of Claims 18, 20, 36-39 and 45-47 under 35 U.S.C. 102(b) as being anticipated by Gettings et al. (US 4,908,355) is maintained for the reasons of the record.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. The rejection of Claims 40-44 under 35 U.S.C. 103(a) as being unpatentable over Gettings et al. (US 4,908,355) is maintained for the reasons of the record.

10. The rejection of Claims 27-35 under 35 U.S.C. 103(a) as being unpatentable over Gettings et al. (US 4,908,355) in view of Kropf et al. (US 6,316,030) is maintained for the reasons of the record.

11. Claims 19, 21-26, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gettings et al. (US 4,908,355) in view of either Müller et al. (WO 98/01109 as translated by US 6,248,338) or Dodd et al. (US 6,656,456).

Gettings et al. teach a method of treating skin disorders such as acne (which is an inflammatory disease of the sebaceous glands) by topically applying to the epidermis a composition containing a volatile silicone oil such as cyclomethicone or dimethicone, an abrasive such as talc, mica, starch, titanium dioxide, etc., and an astringent such as aluminum chlorohydrate, zirconium hydroxychloride and aluminum-zirconium salts, as discussed previously. Further, Gettings et al. teach that acne is accompanied by "microbially generated odors".

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See col. 3, line 42. The reference does not explicitly teach distarch phosphate or cyclodextrin of the instant claims. However, Müller et al. teach using distarch phosphate in skin or hair care composition as stability improver, as a viscosity regulator, as a (co)emulsifier and as an agent for improving skin feel and increasing water retention capacity of the skin. See col. 3, lines 27-28; col. 5, lines 23-65. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the composition of Gettings et al. such that to employ distarch phosphate. One having ordinary skill in the art would have been motivated to do this to obtain compositions having improved stability, good skin feel and moisturizing effect as suggested by Müller et al. Alternatively, Dodd et al. teach skin deodorizing compositions containing cyclodextrin as an odor control agent. See col. 4, lines 1-16. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the composition of Gettings et al. such that to employ cyclodextrin. One having ordinary skill in the art would have been motivated to do this to obtain compositions having improved odor control as suggested by Dodd et al. With respect to Claims 23-26, which recite the concentration of the antiperspirant active, it is the Examiner's opinion that the determination of optimal or workable concentration of the antiperspirant actives by routine experimentation is obvious and within the skill of the art. One having ordinary skill in the art would have been motivated to do this to obtain the desired astringent properties of the composition. Further, there appears to be no

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criticality in the claimed concentration since the prior art recognizes and obtains the same acne treating effect.

Response to Arguments

12. Applicant's arguments filed 8/1/05 have been fully considered but they are not persuasive.

With respect to the 102(b) rejection over Gettings et al., the Applicant argues:

"...the Gettings disclosure is not sufficiently focused enough to constitute an anticipation. The Examiner does not point to any specific embodiment having all of the ingredients required by the instant claims. Instead, the Examiner points to broad generic teachings wherein some of the instant ingredients, such as Gettings abrasive and astringent are only optional ingredients. Thus, for example, Gettings teaches at column 9, lines 40 ff, that the composition 'may also include * * * an abrasive': and at column 9, lines 46 ff, 'there may be included an astringent.' Nowhere is it even disclosed definitively in Gettings a combination having both an abrasive and an astringent. The lack of such definitive teaching of such a combination precludes anticipation. In this regard, it is not sufficient for anticipation that the prior art include a laundry list of possible ingredients, the correct selection of which would render the claimed invention. Rather, the prior art must be sufficiently focused as to place such selection in the possession of the public. Clearly, Gettings is not sufficiently focused to this extent. Thus, the Examiner points to nothing other than these broad generic passages as teaching the present invention. Applicants submit that such teachings fall far short of the focus needed for anticipation." See p. 9 of the reply.

In response, the Applicant's attention is directed to Claim 3 of Gettings et al., which recites the claimed combination of an abrasive and an astringent. Further, Gettings et al. teach a limited number of possible astringents and abrasives, so that one of ordinary skill in the art would be able to "at once envisage" the

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claimed combination of the ingredients. See MPEP 2131.02. Therefore, the Gettings et al. reference is "sufficiently focused" to be anticipatory.

With respect to the 103(a) rejection of Claims 19 and 21-26, the Applicant argues:

"...Gettings at column 9, lines 42 and 47, expressly teaches that the abrasive and astringent are 'selected from the group consisting of' the recited ingredients. Persons skilled in the art are well aware of the significance of this wording, and that it indicates in no uncertain terms that unrecited ingredients are not included and are not to be used. Consequently, such persons would not, in fact, have been motivated by Muller and Dodd to use distarch phosphate and/or cyclodextrin since these ingredients are not among the list in Gettings." See pp. 10-11 of the reply.

In response, the phrase "selected from the group consisting of" is a standard Markush-type language and merely indicates the preferred embodiment of the reference. Indeed, such language cannot be interpreted as "teaching away" from substituting the recited compounds for its functional equivalent and/or adding other ingredients to the composition. In this case, the motivation to employ distarch phosphate or cyclodextrin in the compositions of Gettings et al. come from the Müller et al. or Dodd et al. references, which teach the desirability/beneficial effects of these additional ingredients. Thus, Müller et al. teach using distarch phosphate in skin or hair care composition as stability improver, as a viscosity regulator, as a (co)emulsifier and as an agent for improving skin feel and increasing water retention capacity of the skin, as discussed above. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the composition of

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Gettings et al. such that to employ distarch phosphate. One having ordinary skill in the art would have been motivated to do this to obtain compositions having improved stability, good skin feel and moisturizing effect as suggested by Müller et al. Alternatively, Dodd et al. teach skin deodorizing compositions containing cyclodextrin as an odor control agent, as discussed above. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the composition of Gettings et al. such that to employ cyclodextrin. One having ordinary skill in the art would have been motivated to do this to obtain compositions having improved odor control as suggested by Dodd et al. It has been long held that the strongest rationale for combining references is a recognition, expressly or implicitly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some **advantage or expected beneficial result** would have been produced by their combination. See *In re Sernaker* 17 USPQ 1, 5-6 (Fed. Cir. 1983) and MPEP 2144. (emphasis added).

With respect to the 103(a) rejection of Claims 27-35, the Applicant argues:

"...As noted above, Gettings recites his list of astringents using the closed terminology 'selected from the group consisting of.' Persons skilled in the art would, thus, not have been motivated to use astringents other than those recited." See p. 11 of the reply.

Once again, it is the Examiner's opinion that , the phrase "selected from the group consisting of" is a standard Markush-type language and merely indicates

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the preferred embodiment of the reference. Indeed, such language cannot be interpreted as "teaching away" from substituting the recited compounds for its functional equivalent and/or adding other ingredients to the composition. In this case, the motivation to substitute one known astringent for another come from a knowledge generally available to one of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use aluminum hydroxylactate of Kropf et al. in compositions of Gettings et al. with a reasonable expectation of achieving the same astringent effect because aluminum hydroxylactate of Kropf et al. is a known astringent/antiperspirant salt commonly used for the same art-recognized purpose as aluminum chlorohydrate of Gettings et al. Selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Conclusion

13. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

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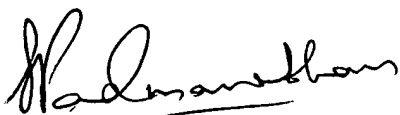
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ml

9/24/05


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